

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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7
8 *Ex parte* CARL E. WHITCOMB
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11 Appeal 2007-2052
12 Application 10/823,379
13 Technology Center 3600
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16 Decided: November 19, 2007
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19 *Before* WILLIAM F. PATE, III, JENNIFER D. BAHR, and DAVID B.
20 WALKER, *Administrative Patent Judges*.
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22 PATE, III, *Administrative Patent Judge*.
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24 DECISION ON APPEAL
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26 STATEMENT OF CASE

27 Appellant appeals under 35 U.S.C. § 134 (2002) from a Final
28 Rejection of claims 1-24, 26-29, 31-38, 40-41, and 60-63. Claims 25, 30,
29 39, 42-59, and 64 stand withdrawn from consideration. We have jurisdiction
30 under 35 U.S.C. § 6(b) (2002).

31 Appellant invented a plant container to address the problem of root
32 circling. The invented plant container includes a base with a plurality of
33 radially directed channels for guiding plant roots.

34 Independent claims 1 and 60 read as follows:

35 1. A plant container, comprising:

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1 a sidewall having a plurality of shoulders; and
2 a base supported on the shoulders, the base having
3 an upwardly facing surface with a plurality of
4 radially directed channels.
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6 60. A plant container, comprising:
7 a container sidewall; and
8 a base secured to the container sidewall, the base
9 having an upwardly facing surface with a plurality
10 of radially directed channels.
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12 The prior art relied upon by the Examiner in rejecting the claims on
13appeal is:

14	Waterer	603,492	May 3, 1898
15	Anderson	4,628,634	Dec. 16, 1986
16	Single	GB 2350272A	Nov. 29, 2000

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18 The Examiner rejected claims 1-4, 9-11, 13, 14, 26-28, 31, 35, 60, 62,
19and 63 under 35 U.S.C. § 103(a) as being unpatentable over Single in view
20of Waterer. The Examiner also rejected claims 5-8, 12, 15-24, 29, 32-34,
2136-38, 40, 41, and 61 under U.S.C. § 103(a) as being unpatentable over
22Single and Waterer, in further view of Anderson.

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24 We AFFIRM-IN-PART.

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ISSUE

27 Has Appellant shown that the Examiner failed to establish that one of
28ordinary skilled in the art would modify the base of the plant container

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1disclosed in Single to incorporate the radial ribs provided on the stand of
2Waterer?

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5 FINDINGS OF FACT

6 The record supports the following findings of fact (FF) by
7preponderance of the evidence.

8 1. Single discloses a plant root container 5 including a sidewall 2
9having a plurality of shoulders 26 and a base 18, 27 supported on the
10shoulders, the base having an upwardly facing surface (Figs. 2, 4 and 10;
11Single 3, ll.13-19; Single 4, ll. 34-44).

12 2. Waterer discloses a plant container including a side wall 2 and a
13base 20 secured to the side wall, the base having an upwardly facing surface
14with a plurality of radially directed channels formed between raised ribs 22
15(Figs. 1 and 5; Waterer 1, ll. 54-60 and ll. 95-97).

16 3. The jardinière disclosed in Waterer is a plant container because
17when in use, a plant is contained therein, even though the plant itself may be
18within another container placed within the jardinière (Fig. 1).

19 4. The base of Waterer is secured by being supported around its
20periphery by the bottom end of the sidewall (Fig. 1).

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22 PRINCIPLES OF LAW

23 A claim is anticipated under 35 U.S.C. § 102 “if each and every
24element as set forth in the claim is found, either expressly or inherently
described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co.*

1of *California*, 814 F.2d 628, 631 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827
2(1987).

3 In addition, 35 U.S.C. § 103 “forbids issuance of a patent when ‘the
4differences between the subject matter sought to be patented and the prior art
5are such that the subject matter as a whole would have been obvious at the
6time the invention was made to a person having ordinary skill in the art to
7which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct.
81727, 1734 (2007). The Court stated that obvious analysis “should be made
9explicit.” *Id.* at 1740-41, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir.
102006) (“[R]ejections on obviousness grounds cannot be sustained by mere
11conclusory statements; instead, there must be some articulated reasoning
12with some rational underpinning to support the legal conclusion of
13obviousness”). However, “the analysis need not seek out precise teachings
14directed to the specific subject matter of the challenged claim, for a court
15can take account of the inferences and creative steps that a person of
16ordinary skill in the art would employ.” *Id.*

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18 ANALYSIS

19 Claims 1-4, 9-11, 13, 14, 26-28, 31, 35, 60, 62, and 63

20 The Examiner rejected independent claim 1 noting that Single
21discloses a plant container satisfying all of the limitations of claim 1 except
22for radially directed channels provided on the upwardly facing surface of the
23base (Final Rejection 2, II. 14-17). The Examiner cites Waterer as disclosing
24a jardinière for a plant container having a stand with radial ribs and asserts
25that one of ordinary skill in the art would have been motivated to combine

1Single with Waterer in order to permit water to flow from a central area of
2the plant container (Final Rejection 2, ll. 17-21; and Ans., 3, ll. 16-20). The
3Examiner further asserts that the channels of Waterer are structurally
4capable of guiding roots (Ans., 4, ll. 18-23).

5 Appellant contends that the subject matter of claim 1 would not have
6been obvious to one of ordinary skill in the art and that the Examiner has not
7presented sufficient evidence as to why one of ordinary skill would combine
8Single and Waterer (Br., 9, l. 26-Br., 15, l. 12). The Appellant also contends
9that the Examiner's rejection is based on impermissible hindsight analysis
10(Br., 15, l. 13-Br., 17, l. 11). We agree with the Appellant.

11 The Examiner has failed to articulate reasoning with rational
12underpinning to support the conclusion that it would have been obvious to
13one of ordinary skill to combine Single and Waterer in the manner
14suggested. The record fails to show why one of ordinary skill would have
15looked to the jardinière of Waterer as disclosing a stand for elevating a plant
16container to allow drainage of water from a plant container; extract the
17radially extending ribs of the stand; and provide such ribs on the base of the
18plant container of Anderson.

19 The motivation articulated by the Examiner is that provision of such
20ribs allows water to flow from a central area of the plant container (Final
21Rejection 2, ll. 17-21; and Ans., 3, ll. 16-20). However, the Single reference
22does not address the issue of water flow within the plant container or the
23desirability of directing water from the central area of the plant container
24(Br., 13, ll. 13-14; and Br., 14, ll. 11-14). While obviousness analysis does
25not require the Examiner to identify specific teachings, suggestions, or

1motivations in the references in order to combine prior art references, the
2Examiner should provide articulated reasoning with rational underpinnings
3in support of obviousness. *See KSR*, 127 S.Ct. at 1740-41. The rational
4nexus between providing ribs for elevating a plant container for drainage as
5disclosed in the jardinière of Waterer and providing ribs at a base of the
6plant container disclosed in Single has not been established by the Examiner.

7 Accordingly, we conclude that although the Examiner has shown all
8claimed elements were known in the prior art, the Examiner has not given a
9rational reason as to why one skilled in the art would have combined the
10prior art elements to make Appellant's claimed invention. Thus, Appellant
11has shown that the Examiner erred in rejecting independent claim 1 and
12claims 2-4, 9-11, 13, 14, 26-28, 31, and 35, ultimately dependent on claim 1.

13 Independent claim 60 does not have the limitation requiring a plurality
14of shoulders that is recited in claim 1. We find that claim 60 is anticipated
15by Waterer which discloses each and every limitation of the claim (FF 2-4).
16Waterer also shows that the channels are free from obstructions as recited in
17dependent claim 62, and that the ribs define eight channels as recited in
18dependent claim 63. Because we have found that claims 60, 62, and 63 are
19anticipated by Waterer, we affirm the § 103 rejection of these claims,
20anticipation being "the epitome of obviousness." *See In re McDaniel*, 293
21F.3d 1379, 1385 (Fed. Cir. 2002) (citations and internal quotation marks
22omitted).

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32Application 10/823,379
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1 No time period for taking any subsequent action in connection with
2this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
3§ 1.136(a)(1)(iv) (2006).

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AFFIRMED-IN-PART

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